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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/826,633	04/15/2004	Thomas D. Willis	AFFY-201-102	1327
42145 7590 09/22/2008 Lisa M. Treannic Morse, Barnes-Brown & Pendleton, P.C. Reservoir Place 1601 Trapelo Road Waltham, MA 02451				
EXAMINER				
STAPLES, MARK				
ART UNIT		PAPER NUMBER		
1637				
MAIL DATE		DELIVERY MODE		
09/22/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/826,633

Applicant(s)

WILLIS ET AL.

Examiner

Mark Staples

Art Unit

1637

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05/12/2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 48-71 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 48-71 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 48-71 filed on 11/23/2007 are pending and at issue.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Rejections that are Moot / Withdrawn

Double Patenting Rejections Moot / Withdrawn

2. The provisional rejection of claims 48-71 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 48-72 of formerly copending Application No. 11,335,196 in view of Speel (September 1999) is moot and therefore is withdrawn. Examiner confirms that Application No. 11,335,196 is abandoned.

3. The provisional rejection of claims 48-71 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-14 of formerly copending Application No. 11,375,818 in view of Speel (September 1999) is moot and therefore is withdrawn. Examiner confirms that Application No. 11,375,818 is abandoned.

Claim Rejections Withdrawn - 35 USC § 112 Second Paragraph

4. The rejection of claim 63 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is withdrawn. Applicant correctly points to antecedent basis for "said step of digesting" recited in claim 63.

Rejections that are Maintained

Claim Rejections Maintained - 35 USC § 102

5. The rejection of 48-54 and 56-71 under 35 U.S.C. 102(e) as being anticipated by Gunderson et al. (Application No. 10/264,574 published as United States Patent Application 20030207295 on Nov. 6, 2003 which claims the benefit of an earliest filing date of 04/20/1999) is maintained. Applicant's arguments filed on 05/12/2008 have been fully considered but they are not persuasive.

Applicant submits that the application of Gunderson et al. is involved in an interference (Interference No. 105,547 of Applicants' US Patent No. 6,858,412 with Application No. 10/264,574 of Gunderson et al.) and argues that there is no support in the specification of Gunderson et al. for the claims of Gunderson et al. Examiner does not find adequate evidence at this time for this argument. Applicant is directed to MPEP § 715.07(b) for some possible means of providing evidence.

Applicant further argues that Gunderson et al. do not teach cleaving a circular probe. Examiner disagrees. Gunderson et al. teach cleavage of probes throughout the specification. Specifically, Gunderson et al. teach cleaving circular probes (see paragraph 0064 in which a circular probe is cleaved, also referred to as a "padlock

probe") and teach that the cleaved portions of probes may be amplified through rounds of PCR and detected (see paragraph 0011).

Applicant further argues that Gunderson et al. in teaching the cleaving of amplified probes of Rolling Circle Amplification (RCA in paragraphs 00182 and 10083) obtained from original circular probes is teaching that there are amplified linear probe products which are cleaved. However, it is noted that the original circular probes of RCA are present during cleavage and thus circular probes are inherently cleaved as well as any potential linear probe products.

Claim Rejections Maintained - 35 USC § 103

6. The rejection of claim 55 under 35 U.S.C. 103(a) as being unpatentable over Gunderson et al. as applied to claim 54, and further in view of Carter et al. (1971) is maintained. Applicant's arguments filed on 05/12/2008 have been fully considered but they are not persuasive.

Applicant argues that as the rejection of the claims being anticipated by Gunderson et al. should be withdrawn, so should this rejection be withdrawn. However, the rejection of the claims being anticipated by Gunderson et al. is maintained as given above. Thus this rejection is maintained.

Conclusion

7. No claim is allowed.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Staples whose telephone number is (571) 272-9053. The examiner can normally be reached on Monday through Thursday, 9:00 a.m. to 6:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on (571) 272-0782. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Mark Staples
/M. S./
Examiner, Art Unit 1637
September 15, 2008

/GARY BENZION/
Supervisory Patent Examiner, Art Unit 1637